

#### REMARKS/ARGUMENTS

This paper is submitted in response to the Office Action mailed September 21, 2006. A Request for a Two Month Extension of Time under 37 CFR 1.136(a) is submitted herewith, along with the fee prescribed by 37 CFR 1.17(a)(2). The response is therefore timely. Reconsideration is respectfully requested.

Claims 1-39 are pending. Claim 9 was rejected under 35 U.S.C. §112, second paragraph, for lack of antecedent basis for the term “the openings.” Claims 1-3, 5-7, 14-18, and 20-22 were rejected under 35 U.S.C. §102(b) as anticipated by US 6,723,108 – Jones et al. Claims 8 and 23 were rejected under 35 U.S.C. §103(a) as unpatentable over Jones et al. in view of US 6,623,450 – Dutta. Claim 35 was rejected under 35 U.S.C. §103(a) as unpatentable over Jones et al. in view of US 6,849,081 – Sepetka et al., in further view of Dutta. Claims 4, 9-13, 19, 24-28, and 36-39 were objected to as depending from rejected claims, but were held to define allowable subject matter. Claims 29-34 were allowed.

As explained below, in this response, claim 9 has been amended to overcome the rejection under Section 112, while the remaining rejections are respectfully traversed. Applicant’s arguments traversing these rejections are set forth below.

On behalf of the Applicant, the undersigned attorney thanks Examiner Adams for the courteous and helpful telephonic interview conducted on February 15, 2007. In the interview, the teachings of Jones et al. were discussed, as was the relevance of this reference to the claims. While no agreement was reached, the discussion was helpful to Applicant’s understanding of how the reference was interpreted and applied by the Examiner. The substance of the interview will be referred to in the following arguments traversing the rejections.

#### Amendments to the Specification

The specification has been amended to update the references to application serial numbers to issued patent numbers or patent application publication numbers, as appropriate. In one instance, an erroneous application number has been corrected and updated to the correct patent application publication number. No new matter has been added.

Amendments to the Claims

Claim 9 has been amended to provide an antecedent basis for the term “the openings,” thereby overcoming the rejection under Section 112.

5    Rejections under Sections 102(b) and 103(a)

Claims 1-3, 5-8, 14-18, 20-23, and 35 were rejected as unpatentable over Jones et al., taken either by itself or in combination with one or more of the secondary references. These rejections are respectfully traversed.

It was the Examiner’s position that Jones et al. discloses Applicant’s invention “substantially as claimed.” Specifically, and critical to the Examiner’s position, was the Examiner’s contention that Jones et al. discloses “an outer element [12] coaxially surrounding and in intimate contact with the intermediate element [and] defining a gap or opening through which the intermediate element is exposed....” During the aforesaid telephonic interview, Applicant respectfully pointed out to the Examiner that the element 12 in Jones et al. is not part of the vaso-occlusive (“embolization”) device disclosed therein. Rather, element 12 is clearly shown and described as a catheter through which the vaso-occlusive device is deployed. See, e.g., column 4 lines 61-67 and column 6 lines 26-39. It is clear that the vaso-occlusive or embolization device 18 of Jones et al., once pushed through the catheter 12, resides in and expands in the target vessel without the presence of the catheter; indeed, it performs the embolization or vascular occlusion function only after it “exits the lumen of the catheter 12.” Thus, as explained in the interview, the catheter 12 is not a part of the vaso-occlusive device 18, and, therefore, the embolization device 18 has no outer element coaxial with the non-metallic (foam) element 22. With no outer element, as defined in Applicant’s claims, there can also be no “gap or opening through which the intermediate element is exposed,” as further defined in the claims.

25       From the above-referenced interview, Applicant understands that the Examiner asserts that the catheter 12 of Jones et al. can occlude a blood vessel when it is used to deploy the embolization device 12. In response, Applicant respectfully points out that to function in the manner asserted by the Examiner, the catheter 12 would need to be left in place in the blood vessel, which is contrary to the teachings of the reference. As taught by Jones et al., the catheter 12 is withdrawn from the vessel, leaving only the device 18 remaining in the vessel to occlude or em-

bolize it. See, e.g. Figs. 6A-C. Moreover, as clearly shown in Figs. 6A-C, the catheter 12 is substantially smaller in diameter than the vessel 36, and is thus inherently incapable of occluding it.

Turning to the specific language of the claims, claim 1 defines, *inter alia*, “an outer element coaxially surrounding the intermediate element and in intimate contact therewith, the outer element defining a gap or opening through which the intermediate element is exposed....”

Likewise, claim 14 defines, *inter alia*, “first, second, and third ... elements arranged coaxially, wherein ... the third element is an outer element having an opening or gap through which the intermediate element is exposed....” As discussed above, there is nothing in Jones et al., taken singly or in combination with the secondary references, that teaches or suggests the structure defined in these claims. Accordingly, it is respectfully submitted that independent claims 1 and 14 define patentably over the art of record, taken singly or in any combination that may reasonably suggest itself to those skilled in the pertinent arts.

Claims 2-13 depend from claim 1, and claims 15-28 depend from claim 14. These dependent claims further define the patentable features of the invention, and should be allowed along with independent claims 1, and 14, respectively, for the reasons set forth above. Moreover, it has already been ruled that claims 4, 9-13, 19, and 24-28 define patentable subject matter, and with the allowability of their respective base claims, as discussed above, the objection to these claims has been overcome, and they are respectfully submitted to be allowable.

The rejection of claim 35 is respectfully traversed, on the grounds that it depends from allowed claim 29. If claim 29 is allowable, claim 35 should also be allowable.

#### Objection to Claims 36-39

Claims 36-39 were objected to as depending from a rejected base claim. All of these claims depend from claim 29, which has been allowed. Therefore, it is respectfully submitted that the objection to claims 36-39 is unfounded, and that these claims should be allowed along with claim 29.

#### Double Patenting

The Office Action maintained that claims 1-39 of the subject application conflict with claims 1-10 and 18-25 of commonly-assigned, later-filed, co-pending Application No.

11/089,207. This part of the Office Action was discussed in the above-mentioned telephonic interview, in which Applicant acknowledged that requirements of 37 CFR 1.78(b), as set forth in the Office Action. It was agreed, however, that the double patenting issue is not yet ripe. Should prosecution of this application close with claims that are in conflict with any claims in the later-filed application, the conflict would be addressed in the later-filed application by canceling or amending the conflicting claims, and/or by filing a terminal disclaimer under 37 CFR 1.321(c).

5 **Summary and Conclusion**

In summary, it is respectfully submitted that claims 1-39 are patentable over the art of record, and should be allowed. Passage of the application to issue is therefore earnestly solicited.

10 Should there be any issues remaining in the application, the Examiner is respectfully requested to telephone the undersigned attorney to expedite the prosecution of this application to issue.

15 Respectfully submitted,

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